

**PATENT**

Serial No.: 09/125,700  
Atty. Docket Number NC13479

**REMARKS**

In items 1,2, 3, and 4 of Office Action dated December 13, 2002, the Examiner has issued a Restriction Requirement. The claims were restricted to two groups (as quoted from Office action):

5        "I. Claim 1-17, drawn to a specic layout of a phone structure (such as fig. 5), classified in class 379, subclass 433.01.

      II. Claims 18-24, drawn to a detachable external (decorative type) housing wrapping around an electronic device (such as fig. 1), classified in class 379, subclass 433.11."

10       Applicant has elected group I without traverse with leave to file a continuation for the non-elected claims. Applicant is dividing out claims 18-24 and filing them in a Continuation-In-Part application United States Application Number 10/376,740 filed on Feb. 28, 2003, to put the present application in condition for allowance or appeal.

15       The filing of the Continuation-in-Part is not to be deemed as an admission that new material has been added to the application as originally filed. Law and policy favors Continuation-in-Part applications and the mere filing of a CIP is not of itself an admission that the matter is new or that the original application was legally insufficient to support the claims. *Paperless Accounting, Inc. v. Bay Area Rapid Transit System*, 804 F.2d 659, 231 USPQ 649 (Fed. Cir. 1986).

20       Regarding Item 4 on pages 2 & 3 of the Office Action mailed December 13, 2002. I, Steven Shaw, Reg. Number 39,368 did not acknowledge that any claims were drawn to any specific drawings. It appears by the Examiner's Office Actions and discussions with him on the phone that he is using the figures to examine the application instead of the written disclosure.

25       The Examiner has rejected claims 1-17 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner cited claims 1, 15-17, as claiming press-on catch. "The original claims (1-14), the original Fig. 5 (it shows screws 43), and the original

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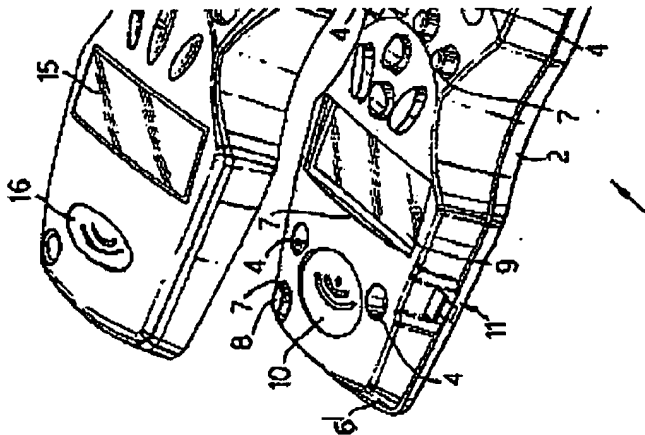
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specification do not have a press-on catch for the phone structure itself. It uses screws 43, not press-on catch. Therefore, it is a new matter."

Applicants disagree with the Examiner. The PCT publication WO 97/32424, from which the application claims priority, clearly shows that the inventor captured the subject matter, excerpts  
5 from the PCT publication are provided herein. The phone structure of figure 1 has push fit/catch closures 11.

On each of the side walls 6 extending in the longitudinal direction of the housing 1 there are two attachment means 11, at a distance from one another, which are designed as push fit/catch closures. They are located in each case near the front and rear ends of the telephone. The attachment means 11 have a catch projection 12 which is biased outwards in a sprung fashion and can be pressed inwards into the housing 1 against the outwardly acting spring force by means of an externally accessible activation element 13. The attachment means serve to attach to the housing 1 an external wall element 14 which is fitted over the shell-shaped housing element 3 and is also of shell-shaped design.



10 The original claims themselves demonstrate that the inventors captured the invention in the written disclosure. The specification need only explain how to make and use the invention without undue experimentation. *Vaech*, 947 F.2d at 495, 20 USPQ2d at 1444; *Wands*, 858 F.2d

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at 736-37, 8 USPQ2d at 1404; In re Fisher, 427 F.2d 833, at 839, 166 USPQ 18, 24 (CCPA 1970). (The first paragraph of section 112 requires that the scope of protection sought in a claim bear a reasonable correlation to the scope of enablement provided by the specification). Nothing more than objective enablement is required, and therefore it is irrelevant whether this  
5 teaching is provided through broad terminology or illustrative examples. *In re Marzocchi*, 439 F.2d 220 at 223, 169 USPQ 367 at 369 (CCPA 1971).

The Examiner has failed to meet the burden of showing how the "written description" which includes the claims failed to show how a person skilled in the art after reading the specification including the claims would need to use undue experimentation to practice the invention as  
10 defined by claims 1-17.

Please note the following extractions for the WIPO publication WO97/32424.

Page 1 circuit board can provide retaining means or another cover can provide retaining means:

The cover may extend over all or some of the electronic components of the phone. If the cover does not extend over all the components then the retaining means may comprise further articles such as a circuit board or another cover. The cover preferably retains user interface components such as a microphone, a

15 Page 2 "the cover is most preferable "releasably attachable - for example by spring clips":

The cover is preferably attachable to the first housing, either directly or via other components of the retaining means. The cover is most preferably releasably attachable - for example by spring clips.

Page 4 "the attachment means with press-on/catch closure can preferably be used":

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Any desired attachment means can be used to attach the external wall element to the housing of the electronic device, but attachment means with press-on/catch closure can preferably be used. They preferably ensure a secure connection between the external wall element and the housing and, moreover, can suitably be easily used without a special tool being required for them.

Page 10 "only two components are loose...To complete the assembly process the keymat is sat on the membrane 29, the front housing is mated to the rear housing and the two are screwed together with screws 43. Applicants submit that this example does not rule out the use of the  
5 previous citation to the preferred means of press-on catch closures:

At this stage in the assembly process only two components of the phone are loose from the assembly mounted to the rear housing 18; the keymat 24 and the front 19 with its display window 41 fixed in place by adhesive. To complete the assembly process the keymat is sat on the membrane 29, the front housing is mated to the rear housing and the two are screwed together with screws 43.

The original claims are reproduced below to demonstrate that the inventor captured the inventions in the original claim set and thus, the written disclosure.

Claim 1 "housing is released from attachment":

1. An electronic radiotelephone comprising:
  - a first housing;
  - a second housing releasably attachable to the first housing to meet with the first housing around the periphery of the radiotelephone; and
  - retaining means comprising a cover, for holding the electronic components of the radiotelephone to the first housing when the second housing is released from attachment with the first housing.

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Claim 3 "retaining means comprises a circuit board":

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3. An electronic radiotelephone as claimed in claim 1 or 2, wherein the retaining means comprises a circuit board of the radiotelephone.

Claim 5 & 6 "cover is releasably engageable with the circuit board":

5. An electronic radiotelephone as claimed in claim 3 or 4, wherein the cover is arranged to hold components of the radiotelephone between it and the said circuit board.

6. An electronic radiotelephone as claimed in any of claims 3 to 5, wherein the cover is releasably engageable with the circuit board

Claim 10:

10. An electronic radiotelephone as claimed in any preceding claim, comprising at least one key unit for user-actuation of a key sensor, and wherein when the second housing is released from attachment with the first housing the key unit is free to move with respect to the first housing.

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**EXAMINER'S ARGUMENT**

Even without Figure 6, the claims are supported by the specification as filed. The specification clearly teaches one skilled in the art that retaining means may comprise article such as a circuit board or another cover. The user-replaceable cover preferably retains user interface components  
10 such as a microphone, a speaker, a display or a keymat.

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The cover may extend over all or some of the electronic components of the phone. If the cover does not extend over all the components then the retaining means may comprise further articles such as a circuit board or another cover.

The cover preferably retains user interface components such as a microphone, a

The specification further teaches in the very next paragraph after discussing the retaining means. Figure 5 has retaining means such as retaining frame 35, circuit board 23, secured with screw 39. The cover is most preferably releasably attachable – for example by spring clips.

The cover is preferably attachable to the first housing, either directly or via other components of the retaining means. The cover is most preferably releasably attachable – for example by spring clips.

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A retaining frame 35 is then pushed into place over the gasket to hold the gasket, the speaker 33, the LCD unit 30 and the frame 32 to the circuit board 23. The frame 35 has a generally flat top surface 36 and side walls 37. The frame is stamped from aluminium sheet around 80µm thick. The top surface 36 of the frame has a hole 35a for the display, a hole 35b for the key portion 34a, a hole 35c for a locating pin 32b on the plastics frame 32 and a grille 35d of holes for the speaker 33. When the frame 35 is pushed into place it squeezes the speaker and the LCD unit between the circuit board 23 and the gasket 34. The side walls of the cover are forced out slightly and then spring back as clips 38, bent from the side walls 37, engage the lower surface of the circuit board 23. The frame 35 thus clips into place and by bending the walls outward again the cover can be removed if needed. The clips 38 then hold the frame to the circuit board 23 and by means of the frame the gasket, the display unit and the speaker are held to the circuit board 23. For security a screw 39 is then inserted through holes in the upper projection, the plastics frame 32, and the circuit board 23 and then into the lower housing 18.

35 U.S.C. 112 "The specification shall contain a "written" description of the invention.... Applicants submit that the invention has been captured and described in the invention in written "English." Applicants respectfully request that the rejection under 35 U.S. 112 be withdrawn.

5 The Examiner has rejected claims 1-9, 11-12, and 15-17 under 35 USC 102(e) as being anticipated by Kobayashi et al. (US5722055). Nowhere in Kobayashi or any of the other art cited by the Examiner is there any teaching of a user-replaceable housing to modify the external appearance of a radiotelephone by the end-user to suit his or her's personal tastes with a keymat as currently claimed.

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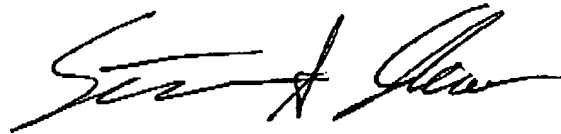
Applicants submit that all pending claims are in condition for allowance and a Notice of Allowance is respectfully requested.

A three month Extension of Time in order to timely file this response by June 13, 2003 is hereby requested. A fee transmittal form is provided herewith.

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Respectfully submitted,

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Dated: JUNE 9, 2003

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